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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,156	02/08/2001	Ursula Murschall	00/053 MFE	4234

7590

11/27/2002

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 11/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/779,156

Applicant(s)

MURSCHALL ET AL.

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

This action is in response to the amendment submitted on September 20, 2002.

***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' remarks, the previous rejections of claims 1 and 7-10 are withdrawn.

***Claim Rejections - 35 USC § 103***

Due to Applicants' remarks, the previous rejection of claims 1, 3, 4, and 10 because they are product-by-process claims are withdrawn; however, they are still rejected because the phrases "incorporated directly into...fed as a masterbatch" in claims 1, 3, and 4 and the phrase "coating has been applied" in claim 10 introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

**Claims 1-5 and 8-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931 as previously stated in the Office Action submitted on May 22, 2002.

As to the new limitation that "the luminous transmittance of the film is reduced when the longitudinal stretch ratio is increased for film of the same thickness" in claim 1, claim 1 is rejected because that phrase introduces a process limitation to the product claim. The

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patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Kim also teaches the same or similar components as in the instant invention and thus, absent any evidence to the contrary, the invention of Kim would have the same optical property of luminous transmittance as in the instant invention. Such a level of luminous transmittance is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the luminous transmittance, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. luminous transmittance) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the amount of light transmitted, transparency, and reflectiveness of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the film with the limitations of the level of luminous transmittance since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931 in view of von Meer, U.S. Pat. No. 4,384,040 as previously stated in the Office Action submitted on May 22, 2002.

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931 in view of Yamazaki, U.S. Pat. No. 6,106,924 as previously stated in the Office Action submitted on May 22, 2002.

***Response to Arguments***

Applicants' argument filed September 20, 2002 have been fully considered but they are not persuasive.

On pages 4 and 5, Applicants argue that Kim does not teach a film where the luminous transmittance is reduced when the longitudinal stretch ratio is increased for a film of similar thickness as in instant claims 1 and 8. Examiner is not persuaded because such a limitation introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Kim also teaches the same or similar components as in the instant invention and thus, absent any evidence to the contrary, the invention of Kim would have the same optical property of luminous transmittance as in the instant invention. Such a level of luminous transmittance is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the luminous transmittance, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. luminous transmittance) fails to render claims patentable in the absence of

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unexpected results. All of the aforementioned limitations are optimizable as they control the amount of light transmitted, transparency, and reflectiveness of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the film with the limitations of the level of luminous transmittance since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

On page 4, Applicants argue that claims 1, 3, 4, and 10 should not have been rejected because they are product-by-process claims. Although possibly misstated, these claims do present process limitations not shown by the art but are still included in the rejection over Kim et al., U.S. Pat. No. 5,660,931 because process limitations add no patentable weight to a product claim. This was not a separate rejection.

On page 5, Applicants argue that von Meer does not supply the deficiencies of Kim relative to the optical property of luminous transmittance as shown in claim 1. Examiner is not persuaded because von Meer is used in combination with Kim to show that it is known in the art to use blue dyes in a polyester resin as in instant claim 6.

On page 5, Applicants argue that Yamazaki does not disclose the deficiencies of Kim relative to the optical property of luminous transmittance as shown in claim 1. Examiner is not persuaded because Yamazaki is used in combination with Kim to show that it is known in the art to use precipitated barium sulfate in the invention of Kim as shown in instant claim 6.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen  
Examiner  
November 25, 2002

CYNTHIA H. KELLY  
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